

UNIT II

TRADE SECRETS

Introduction

Competitive strength usually depends on innovative techniques and accompanying know-how in the industrial and/or commercial field. However, such techniques and know-how are not always protectable by patent law. Firstly, patents are in principle available only for inventions in the field of technology and not for innovative achievements concerning the conduct of business, etc. Moreover, some technical discoveries or information, while providing a valuable commercial advantage for a particular trader, may lack the novelty or inventive step required to make them patentable. Furthermore, while a patent application is pending, as long as the information has not been disclosed to the public, the owner of the information to be patented ought to be protected against any wrongful disclosure of the information by others, regardless of whether or not the application eventually leads to the grant of a patent. All such information can be classified as a trade secret. Although the Paris Convention does not mention trade secrets as such, Article 10bis on unfair competition requires protection against any act of competition contrary to honest practices in industrial or commercial matters; the need for protection against wrongful disclosure of undisclosed information (another term for trade secrets) is generally recognized.

There are many examples of trade secrets, which are very well guarded. To name just one, the formula of soft drink coca-cola is one of the most successfully guarded trade secret till date. Naturally, lot of efforts are taken to keep this secret, which is quite expensive affair. The trade secrets are also kept at small scale. You may have a bakery in your locality, which bakes the cakes or cookies in unique way. The recipes of these items are the trade secrets of that baker. There are many traditional dishes cooked in a family, whose recipes are passed on from generation to generation, but kept just within the family. All these types of trade secrets are also protected in some national laws.

In this Unit, you will learn about the protection of trade secrets. Some basic aspects like how to guard a trade secret, what is meant by violation of a trade secret, how to make a choice between patent protection or trade secret, are also discussed.

What is a trade secret? Before we start discussing the reasons for protecting a trade secret, let us first understand, what is a trade secret?

There are several lines of inquiry that serve to determine what information constitutes a trade secret: the extent to which the information is known to the public or within a particular trade or industry, the amount of effort and money expended by the trader in developing the secret information, the value of that information to the trader and to his competitors, the extent of measures taken by the trader to guard the secrecy of the information and the ease or difficulty with which the information could be properly acquired by others.

From a subjective point of view, the trader involved must have a considerable interest in keeping certain information as a trade secret. Although contractual obligations are not necessary, the trader must have shown the intention to have the information treated as a secret. Frequently, specific measures to maintain the secrecy of the particular information are also required. The fact that the information has been supplied confidentially will not always be sufficient. In some countries (for example, the United States of America and Japan), the efforts made by the owner of the information to keep it secret are considered by courts to be of primary importance in determining whether the information constitutes a trade secret at all.

From an objective point of view, the information must, in order to qualify as a trade secret, be known to a limited group of persons only, that is, it must not be generally known to experts or to competitors in the field. Even patent applications may be regarded as trade secrets as long as they are not published by the patent office. Therefore, external publications or other information that is readily available will not be considered secret. For example, the use or disclosure of a trade secret by a person who has acquired it in a legitimate business transaction and without any negligence is not deemed unfair. On the other hand, absolute secrecy is not a requirement, for the information might also be discovered independently by others. Also, business partners can be informed without loss of secrecy if it is obvious that the information has to remain secret. Factors that indicate whether the information has the necessary degree of confidentiality to constitute a protectable trade secret are whether it contains material that is not confidential if looked at in isolation, whether it has necessarily to be acquired by employees if they are to work efficiently and whether it is restricted to senior management or is also known at the junior level. Still, the most solid proof is the strict confidentiality of the information and the contractual duty to keep it secret.

A trade secret can be any formula, pattern, idea, process, physical device or a compilation of information which provides its owner a competitive advantage in the market. The trade secret is expected to be treated in such a way that it is not available to others (public or competitors) unless obtained by theft or by improper acquisition.

Some potential matters of trade secret can be a recipe, chemical formula, survey methods, confidential

data, computer programmes, manufacturing process, marketing strategies, financial strategies or a new invention for which patent application is not yet filed.

Why to protect a trade secret?

The information is usually protected as a trade secret when the other forms of IPR protection cannot be used. For example, an idea cannot be protected by patent, it cannot be protected by a copyright, unless it is expressed or fixed. However, to protect this idea can be very crucial from the commercial point of view. In such case, it has to be protected as a trade secret. Many other matters like progress of developing a new product, customer list with critical comments, a negative know-how, which gives information about ineffectiveness of certain product or process, cannot be protected by any other IPR tools, without disclosing them. All this information can be kept as trade secrets.

Trade Secret versus Patent

The patent protection guarantees that nobody can work your invention without your prior authorization. This protection is valid within the term of the patent protection (typically 20 years). However, in your patent application, you disclose the patent for public knowledge and the moment the term of patent protection ends, the information disclosed in your application becomes a public domain information. Anybody is free to use it. Further, you have to pay prescribed fee for maintaining the patent protection valid and that too, in all the countries, where its protection is expected.

Now, keeping a trade secret can be a much simpler and cheaper method, if you can maintain secrecy in your organization. The less the number of people having access to the entire secret information the better are the chances of retaining the trade secret. The trade secret can be held indefinitely.

There are, however, some disadvantages of protecting confidential business information as a trade secret. If the secret is embodied in an innovative product, others may be able to inspect it, dissect it and analyze it (i.e. reverse engineer it) and find out the secret and be thereafter entitled to use it. Trade secret protection of an invention in fact does not provide the exclusive right to exclude third parties from making commercial use of it. Only patents and utility models can provide this type of protection. Once the secret is made public, anyone may have access to it and use it at will. Also a trade secret may be patented by someone else who developed the relevant information by legitimate means.

A trade secret is more difficult to enforce than a patent. The level of protection granted to trade secrets varies significantly from country to country, but is generally considered weak, particularly when compared with the protection granted by a patent.

Hence, though decision between trade secret and patent protection will have to be taken on a case-by-case basis, in the following circumstances it would be advisable to make use of trade secret protection:

- When the secret is not patentable; or
- When the likelihood is high that the information can be kept secret for a considerable period of time. If the secret information consists of a patentable invention, trade secret protection would only be convenient if the secret can be kept confidential for over 20 years (period of protection of a patent) and if others are not likely to come up with the same invention in a legitimate way; or
- When the trade secret is not considered to be of such great value to be deemed worth a patent; or

When the secret relates to a manufacturing process rather than to a product, as products would be more likely to be reverse engineered; or

- When you have applied for a patent and are waiting for the patent to be granted.

It is important to bear in mind, however, that trade secret protection is generally weak in most countries, that the conditions for, and scope of, its protection may vary significantly from country to country depending on the existing statutory mechanisms and case law, and that the courts may require very significant and possibly costly efforts to preserve secrecy.

Tools to protect a trade secret

Contrary to patents, trade secrets are protected without registration, that is, trade secrets are protected without any procedural formalities. Consequently, a trade secret can be protected for an unlimited period of time. There are, however, some conditions for the information to be considered a trade secret. Compliance with such conditions may turn out to be more difficult and costly than it would appear at first glance. While these conditions vary from country to country, some general standards exist which are referred to in Art. 39 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement):

- The information must be secret (i.e. it is not generally known among, or readily accessible to, circles that normally deal with the kind of information in question);
- It must have commercial value because it is a secret; and
- It must be subjected to reasonable steps by the rightful holder of the information to keep it secret.

The trade secrets are widely used by the small and medium scale enterprises (SMEs). In fact, many such enterprises rely almost exclusively on trade secrets for the protection of their IP.

This may include:

- Trade secret policy: Making sure that a limited number of people know the secret and that, all those who do, are well aware that it is confidential information.
- Employee agreement: Signing confidentiality agreements with business partners whenever disclosing confidential information.
- Non-disclosure Agreements: Including confidentiality agreements within employees' contracts. Under the law of many countries, however, employees owe confidentiality to their employer even without such agreements.
- Adequate documents: The duty to maintain confidentiality on the employer's secrets generally remains even after the employee has left the employment. This duty may be limited to a certain period of time after the employment ceases.
- Security Systems: It is important to make sure that enterprises take all necessary measures to protect their trade secrets effectively.

Trade Marks

Introduction

Trademarks existed in the ancient world. As long as 3000 years ago, Indian craftsmen used to engrave their signatures on their artistic creations before sending them to Iran. Later on, over 100 different Roman pottery marks were in use, including the FORTIS brand that became so famous that it was copied and counterfeited. With the flourishing trade in the Middle Ages the use of trademarks increased. Today trademarks (often abbreviated as TM in English) are in common usage and most people on the planet could distinguish between the trademarks for the two soft drinks Pepsi-Cola_ and Coca-Cola_. The growing importance of trademarks in commercial activities is due to the increased competition among companies undertaking trade in more than one country. Trademarks have been used to simplify the identification by consumers of goods or

services, as well as their quality and value. Thus, a trademark may be considered as a tool of communication used by producers to attract consumers.

There are basically two main characteristics for a trademark: it must be distinctive and it should not be deceptive.

Therefore a formal definition of the term trademark could be:

“A trademark is defined as a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from the goods and services of the competitors.” To be able to be registered as trademark, a mark should be distinctive and should be capable of graphical representation.

The different kinds of trademarks include:

Logo: It refers to the pictorial representation. Objects like animals, birds, landscape buildings fall within this category. A collection of devices may become distinctive (logo of bamboo grove or expression ‘Bans ka Jungle’ consider distinctive whereas logo of a bamboo for extract prepared out of a particular bamboo is considered descriptive) Examples: MacDonald’s double arches, Apple computer’s bitten apple.

Letter: It is a mark which is the identity created out of letter forms and has its inbuilt strength of distinctivity and individuality. Examples: IBM, GM, LG

Numerals: These can be registered as trademark upon evidence of user. Examples: 555

Symbol: A symbol is a visual depiction of a manufacture or a company and gives an identity to it. Examples: B.M.W, Benz etc.

Brand: It refers to those kinds of marks which are branded on the goods or services a process of applying mark on goods constituting the trademark. It implies that the symbol itself constitutes the trademark.

Example: Cycle brand agarbathi, home or ship brand for matches.

Label or ticket: Means a composite mark containing various features including devices, words, usually painted on paper and attached to the goods themselves. Example: Coca cola label on the soft drink bottle.

Name: Is the word signifying a name, surname or a personal name or an abbreviation thereof or the name of a sect, caste or tribe. Yes, in a similar way a particular name also signifies a product or service as TM. Example; Cadbury, Nokia

Colour: Under Section 2 of 1999 Act provides a trademark can be granted over a colour or combination of colours. However, such protection is possible only if the colour does not describe the nature of the product. For example GREEN for eco-friendly products may not be

registrable because of its descriptive nature but green for head phones would be protectable. For protecting a colour, a written description of the colour might be required by the trademark registry.

Sound: A sequence of chime-like musical notes which are in the key of C and sound the notes G,B,C, the G being the one just below the middle C, and the C, and the C being middle C was registered in the name of National broadcasting corporation for its services of broadcasting. In 2001 IBM unveiled a sound signature for its e-commerce business centers. The sound trademarks are becoming popular.

Smell: registration of smell is debatable. However there are instances of smell being granted the trademark. Example: the smell reminiscent of Roses Applied to tyres, was registered as trade mark by Sumitomo tyres.

DIFFERENT FORMS OF TRADE MARKS

Collective Marks

A collective mark distinguishes the goods or services of members of the Association which owns the mark from those of others. Members of the Association are the authorized users of the mark, and the use of the mark by the members of the Association is considered as the use by the proprietor. A collective mark cannot be registered if it is likely to deceive the public, or confuse the public that the mark may be something other than a collective mark. In such a case the Registrar may require that the mark may carry some indication that it is a collective mark. The Association registered as the proprietor of a collective mark can file a suit for infringement. A collective mark can be removed from the register on following additional grounds (Refer 5.6):

- The manner it has been used is liable to mislead the public; or
- The proprietor has failed to observe, or to secure the observance of the regulations governing the use of the mark.

Certification Marks

Certification trademarks certify goods in respect of origin, material, mode of manufacture, quality, accuracy or some other characteristics of the goods, which bear them. They distinguish goods so certified from competing goods which do not carry the certification mark. Thus, these marks benefit the consumer. The trading community is not always enthusiastic about these marks. Some examples of certification trademarks are ISI, Agmark, Woolmark, Sanforized.

Because certification trademarks are functionally different from other trademarks, which distinguish a trader's/producer's goods from those of others, several provisions of the Trade Marks Act, 1999, do not apply to these marks. These provisions pertain to absolute grounds of refusal of registration:

A certification mark need not be distinctive for registration. Similarly, the provision denying registration to a mark if it consists exclusively of marks or indications which have become customary in the current language or in the bona fide and established practices of the trade is not applicable to certification marks.

- Application for registration, advertisement of application and opposition to it.
- The procedure as applied to other trademarks is different in the case of certification marks.
- Rights conferred by registration, infringement, limits on the effect of registered trademark, assignment or transmission, removal from register and limitation on ground of non-use, registered users, power of registrar for variation or cancellation of registration as registered user, right of registered user to take proceedings against infringement, registered user not to have right of assignment or transmission.

Registration of Certification Trademarks

A certification mark cannot be registered in the name of a person who carries on a trade in goods of the kind certified. For registration, the proprietor makes an application in a prescribed manner to the Registrar, accompanied by the regulations governing the use of the certification trademark, which are to be deposited with Trademarks Registry. Acceptance of the application, withdrawal of acceptance and incorporation of any correction or amendment is to be done as provided for other trademarks subject to the restriction on the persons who could be the proprietor of a certification mark as stated earlier.

While accepting the application the Registrar takes into account the following matters:

- Whether the applicant is competent to certify the concerned goods;
- Whether the draft of regulations governing the use of the mark is satisfactory;
- Whether the registration would be to the public advantage in all the circumstances.

If the acceptance and approval would require modification or imposition of conditions/limitation the Registrar shall not decide the matter without giving the applicant an opportunity to be heard. On acceptance, the application shall be advertised, as in the case of other trademarks, and opposition, if any, for the registration of the certification mark shall have to be considered and decided before proceeding to registration.

Well Known Marks:

Some companies have successfully established, via their trademarks or service marks, worldwide renown. Subsequently, consumers can, without effort, recognize and identify their goods and services, their qualities and their features without referring to the location of the company in question. These trademarks are called well-known marks or famous marks. Examples: Sony, Versace, Louis Vuitton, etc. As there may be companies which intend to take unfair advantage of those well-known marks by creating marks that are similar or that would create confusion with the well-known ones, thus misleading consumers. To overcome this problem, the Paris Convention, the TRIPS Agreement, as well as many national laws, have provided for a special protection of well-known marks. There is no straightforward definition of a well-known mark. What must be defined, however, are the factors to be considered in determining whether a mark is well known or not. These factors include the degree of knowledge or recognition of the mark in the relevant sector of the public and the duration, extent and geographical area of any use of the mark.

Characteristics of a Good Trademark

A trademark should be distinctive. Distinctiveness may be inherent or acquired. An invented word may be inherently distinctive as a trademark e.g. RIN. Other trademarks may have acquired distinctiveness through usage e.g. TATA, Reliance, Revlon. Most brands acquire distinctiveness through use. A brand may depend on the class of goods e.g. Hawkins and Prestige are two distinctive brands in pressure cookers. If the trademark is a word, it should be short and easy to spell, pronounce and remember; if it is a device it should be expressible in a word. The word should be preferably an invented word. Zen, Avon, RIN, Flex are all fine examples. The mark can be denied if it is not considered distinctive. A trademark consisting of parts of a chain wheel and chain to cover a business in chains and chain wheels is not considered distinctive. However, distinctiveness alone is not sufficient for registration of a trademark. It may also depend on whether other traders, without any improper motives, want to use the same mark.

REGISTRABILITY OF TRADEMARK

A trademark that consists of at least one of the following essential characteristics can be registered.

1. The name of a company, individual, or firm represented in a particular or special

manner;

2. The signature of the applicant for registration;
3. One or more invented words;
4. One or more words having no direct reference to the character or quality of the goods except the exceptions listed in the next section;
5. Any other distinctive trademark; and
6. A trademark that has acquired distinctiveness by use over a prolonged period.

A part of a trademark can be registered separately in addition to a whole trademark if it satisfies the requirements of registration of a trademark. The Act also provides for registration of the same or similar trademark by more than one proprietor in the case of honest concurrent use or other special circumstances.

The Act lays down absolute grounds for refusal of registration, as well as the relative grounds for such refusal.

NON-REGISTRABLE TRADEMARKS

The act debars a trademark from registration if it is not distinctive, or consists exclusively of marks or indications which have become customary in the current language and practice. It cannot be registered if it consists exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin, or the time of production of the goods or rendering of the service or other characteristics of the goods or service. Also, a mark falling in any of the following categories is not registrable:

- A mark that is identical with or deceptively similar to a trademark already registered in respect of the same goods or goods of the same description as to deceive the public or cause confusion;
- A mark the use of which would be contrary to any law or which would be disentitled for protection in a court of law;
- A mark comprising or containing scandalous or obscene matter;

- A mark comprising or containing any matter likely to hurt the religious susceptibilities of any class or section; and
- A word which is declared by the World Health Organisation (WHO), and notified by the Registrar as an international non-proprietary name, or a word which is deceptively similar to such name.

Shape trademarks attract prohibition from registration in certain conditions which may arise in a very limited number of cases, and it would be difficult in those cases to satisfy the distinctiveness criterion.

A mark cannot be registered as a trademark, if it consists exclusively of goods

- Which results from the nature of goods themselves? For example, the shape of an apple used for apples or their packaging;
- Which is necessary to obtain a technical result? An exclusively technical shape will be the one if no other shape will perform its function;
- Which gives substantial value to the goods? There may be difficulty in interpreting this provision.

The word exclusively is to be noted here. If a mark has a shape of any of the descriptions given above but has other additional features, it could be considered for registration subject to other essential qualifications for a trademark. Also, an unregistered trademark can continue to have a shape of a description that makes it ineligible for registration.

A trademark, save in rare circumstances as of honest concurrent use, to be decided by the Registrar shall not be registered, if it is identical with an earlier trademark, or if it is similar to an earlier trademark and covers identical goods and services so as to cause confusion in the mind of the public.

If a trademark has similarity or identity with an earlier well-known trademark but is sought to be applied to a different category of goods, it will still not be registered, as it seeks to exploit a

well-known brand for an unfair advantage or may harm the reputation of the earlier, well-known trademark.

If a trademark violates any law, in particular the law of passing off protecting an unregistered trademark, or the law of copyright, it is not registered.

Additionally, the following categories of marks are also not registrable:

- a word which is the commonly used and accepted name of any single chemical element or single chemical compound; and
- a geographical name or a surname or a personal name or any common abbreviation thereof or the name of a sect, caste or tribe in India.

The Act provides for registration of same or similar trademark by more than one proprietor in case of honest, concurrent use, if in the opinion of the Registrar it is proper to do so in the special circumstances.

Where the proprietor of the trademark claims to be entitled to the exclusive use of any part of the trademark, he may apply to register the whole and the part as separate trademarks.

PROCEDURE FOR REGISTRATION OF TRADEMARKS:

In India an office of the Registrar of Trademarks has been established for the maintenance of the Trademark Registry. Controller General of Patents and Designs is also the Registrar of Trademarks. The Register of Trademarks contains the record of all registered trademarks, with names, addresses and description of proprietors and users, assignments and transmissions, and conditions and limitations and the name of registered users.

Any person who claims to be a proprietor of a trademark can apply to the Registrar of Trademarks for its registration. The application may be made in the name of an individual, partners of a firm, a Corporation, any Government Department, a trust or joint applicants claiming to be the proprietor of the trademark. For registration of a trademark the nature of goods or services in relation to which the trademark is to be used has to be specified.

Application

[1] Application in the prescribed form has to be filed in the office of the Trademark Registry within whose territorial limits the principal place of business in India of the applicant, or the first applicant in the case of joint applicants, is situated. The Registrar is required to classify goods and services in accordance with the international classification for registration of trademarks. A single application is sufficient for registration of a trademark for different classes of goods and services; however, the fee is payable for each class separately. If the applicant or any of the joint applicants does not carry on business in India, the application shall be filed in the office of the trademark registry within whose territorial limits the place mentioned in the address for service in India lies.

[2] Every application for registration of a trademark shall contain a representation of the mark in the place provided in the form for the purpose. Five additional representations of the mark have to be supplied with the application.

[3] The application can either be accepted completely or accepted subject to amendments or rejection. It is possible that an application is accepted and later, before registration, the acceptance is found to be in error. In such a case the Registrar, after hearing the applicant may withdraw the acceptance.

Advertisement

Soon after acceptance, the application as accepted, together with the conditions or limitations, if any, is advertised in the Trademarks Journal to provide the public an opportunity to oppose the registration. Any person may, within three months from the date of the advertisement or such further period not exceeding one month, as the registrar may allow, give notice in writing to the Registrar of opposition to the registration. A copy of the notice of opposition is given by the registrar to the applicant to file a counter-statement, etc. The Registrar decides the issue giving both parties due hearing, if required, or after considering their respective views.

If the person giving notice of opposition of the applicant neither resides nor carries on business in India, the Registrar may require him to give security for the cost of proceedings and if such

security is not given the Registrar may treat the opposition (or the application) as abandoned. When the procedure for registration, including the opposition, if any, is satisfactorily complete, the Registrar is mandated to register the mark with effect from the date of application.

Time Period

The registration of a trademark is for a period of ten years, but it may be renewed indefinitely on the payment of the prescribed renewal fees.

Registration is prima facie evidence of validity of the trademark. A registered trademark shall not be held to be invalid on the ground that it was not registrable under the Act except upon evidence of distinctiveness. However, if it is claimed and proved that the trademark had become distinctive due to use by the proprietor at the date of registration, it can be contended that such evidence was not submitted to the Registrar at the time of registration. If a trademark has been registered, even if it lacked distinctiveness, it shall not be declared invalid if, in consequence of the use made of it, it has acquired a distinctive character in relation to the goods or services for which it is registered, between its registration and commencement of the legal proceedings challenging its validity.

DECEPTIVELY SIMILAR TRADEMARKS

The word similar is not defined in the Act. However, a trademark is said to be deceptively similar to another mark if it so nearly resembles that other mark as to be likely to deceive or cause confusion. The deceptively similar mark includes not only confusion but deception also. Near resemblance is mentioned in the Act in connection with registered trademarks in the name of the same proprietor which may closely resemble each other, to deceive or cause confusion in the mind of a user. The Registrar may require them to be registered as associated trademarks.

The following factors are to be taken into consideration when deciding the question of similarity:

- The nature of the marks;
- The degree of resemblance;
- The nature of goods in which they are likely to be used as trademarks;

- The similarity in nature, character, and nature of goods in which it is used;
- The nature of the potential class of consumers; and
- The visual and phonetic similarity.

RIGHTS OF THE OWNER OF THE TRADEMARKS

Registration serves as evidence of the adoption and selection of the trademark for specified goods & services. The proprietor of a registered trademark enjoys the following rights by the registration:

- i. An exclusive right to the use of the trademark to the goods or services in respect of which it has been registered; if the trademark consists of several parts, the exclusive right pertains to the use of the trademark taken as a whole; if the trademark contains matter common to trade and is not distinctive, there is no exclusive right in such parts.
- ii. Registration entitles the proprietor to obtain relief in case of infringement when a similar mark is used on (a) same, or similar, goods or services, (b) dissimilar goods or services.
- iii. Registration forbids other persons, except the registered, or unregistered permitted user to use the registered trademark or a confusingly similar mark about the same goods or services, (or some description of goods and services) about which the mark is registered.
- iv. Once a trademark is registered, the same or confusingly similar mark cannot be registered for the same or similar goods or services. In the case of well-known trademarks, it cannot be registered even for dissimilar goods and services.
- v. A registered trademark shall not be used by anyone unauthorized in business papers and in advertising. Use in comparative advertising should not be contrary to honest practices and should not harm the distinctive character or reputation of the trademark.
- vi. Import of goods and services bearing a mark similar to a registered trademark can be restricted by the registered proprietor.

- vii. A right holder has a right to restrain the use of his registered trademark as trade name or part of a trade name or name of business concern dealing in the same goods or services.
- viii. A registered trademark continues to enjoy all the rights available to an unregistered mark, emerging from common law like passing off action.
- ix. Registration confers the right to assign or transmit the trademark to another person by the registered proprietor.

Exception to Rights

There are exceptions to these rights in certain situations where considerations like vested rights and concurrent use come into play.

Rights of the prior user

If a person A gets registration for a trademark and uses it and another person B has been using the trademark from an earlier time, the right of B to use it is not affected after A's registration, even if B had not opposed it. However, B's growth of business may be affected. But if B's business has got great reputation, A can even be restrained from using the trademark despite registration.

Rights to use one's own name

Registration does not confer a right on the proprietor to interfere with the business of another person who is using, in a bona fide manner, his own name, or that of his place of business or any description of the character, quality of goods or services.

Concurrent use

A mark that has been in concurrent use in the same jurisdiction on the same, similar, dissimilar, or different goods is not affected by the registration of the same mark by another person.

It may be reiterated that there is no exclusive right (i) in parts of a trademark and (ii) in non-distinctive or other matters common to trade. A matter is said to be common to the trade when it is in common use in the trade, or when it is open to the trade to use. It could be a word a symbol or a get-up that any trader in the trade can use and nobody can claim as his own.

REGISTRATION OF ASSIGNMENTS AND TRANSFER

A person entitled by assignment or transmission to a registered trademark shall apply in the prescribed manner to the Registrar to register his title. The Registrar must be satisfied as to proof of his title before registering him as proprietor of the trademark.

Assignment of a registered trademark may sometimes necessitate certain alteration in the mark such as a change in the name of the proprietor.

Licensing of trademarks:

As is in the case of assignment a licensing too has to be in writing and oral licensing is no licensing. However trademark licensed ceases to be valid if there is no connection in the course of trade with the registered proprietor or otherwise becomes deceptive by the act of registered owner.

Difference between assignment and license

there are some basic differences between assignment and license is that assignment is a permanent transfer whereas license is a temporary transfer. Assignment is or without the assignment of the good will and is preferable to have licensing with control over the quality than to assign without good will. License is revocable whereas assignment is not revocable.

INFRINGEMENT

Trademark infringement is a violation of the exclusive rights attaching to a registered trademark without the authorization of the trademark owner or licensee. Infringement may occur when the infringer, uses a trademark which is identical or confusingly similar to a registered trademark owned by another person, in relation to products or services which are identical or similar to the products or services which the registration covers. The owner of such registered trademark may commence legal proceedings against the infringer.

Passing Off

Passing off occurs in the case of unregistered Brand Names. Here, the owner or to say Brand holder has the preferred right over the Brand owing to long and continuous use though the Brand being unregistered (under the Trademark Act), an action of Infringement cannot be initiated. A Passing Off action can be brought in by the original owner or user of a Brand against another person, who in the course of trade, misrepresents to its prospective or ultimate customers about its goods or services in a manner so as to show that they are connected to the goods or services of the original owner and this is done in a calculated fashion to injure the business or goodwill of the original owner or to earn benefit at the cost of the original owner. It is also important that actual deception and actual damage has to be proved for any relief of passing off. It has been settled in catena of authorities that essential characteristics of a passing off action are as follows:

- Misrepresentation
- Made by a person in the course of Trade Mark
- To prospective customers of his or ultimate consumers of goods or services supplied by him
- Which is calculated to injure the business or goodwill of another trade
- Which causes actual damage to a business or goodwill of the trade by whom, the action is brought or we'll probably do so.

Jurisdiction

One of the most important practical benefit given under Section 134 of the Trade Marks Act, 1999 is that a suit for infringement can also be instituted before a District Court / High Court (enjoying Ordinary Original Civil jurisdiction such as High Court of New Delhi, Mumbai, Kolkata or Chennai), within the local limits of whose jurisdiction, at the time of the institution of the suit, the person instituting the suit, actually and voluntarily resides or carries on business or personally work for gain. The person includes the registered proprietor and the registered user. On the other hand, the suit for passing off can only be instituted before a District Court, within the local limits of whose jurisdiction The Defendant is residing, working for gain or carrying on its business; or the cause of action has arisen.

Remedies

A criminal complaint can also be filed in case of infringement / passing off trademark. The Courts can grant an injunction and direct the customs authorities to withhold the infringing material / its shipment or prevent its disposal in any other manner, to protect the interest of the owners of intellectual property rights. This legal proposition can be enforced with/without involving the concerned authorities as a party in the suit.

The relief that a court may usually grant in a suit for infringement or passing off includes a permanent and interim injunction, damages or account of profits, delivery of the infringing goods for destruction, and cost of the legal proceedings. The order of interim injunction may be passed ex parte or after notice. The Interim reliefs in the suit may also include orders for:

- a. Appointment of a local commissioner, for search, seizure, and preservation of infringing goods, account books, and preparation of inventory, etc.
- b. Restraining the infringer from disposing of or dealing with the assets in a manner that may adversely affect the plaintiff's ability to recover damages, costs, or other pecuniary remedies that may be finally awarded to the plaintiff.

CASE STUDIES:

Rights & Remedies of a Trade Mark Owner-

The owner of a registered trademark may commence legal proceedings for trademark infringement to prevent unauthorized use of that trademark. However, registration is not required. The owner of a common law trademark may also file suit, but an unregistered mark may be protectable only within the geographical area within which it has been used or in geographical areas into which it may be reasonably expected to expand.

Two types of remedies are available to the owner of a trademark for unauthorized use of his or her mark or its imitation by a third party. These remedies are:

- an action for infringement' in case of a registered trademark; and
- an action for passing off' in the case of an unregistered trademark

While former is a statutory remedy, the latter is a common law remedy. In an action involving infringement or passing off, a court may grant relief of injunction and/or monetary compensation for damages for loss of business and/or confiscation/destruction of infringing labels and tags etc.

Although registration of trademark is prima facie an evidence of validity of a trademark, yet the registration cannot upstage a prior consistent user of trademark, for the rule is 'priority in adoption prevails over priority in registration'.

Cases of Trade Mark Violation in India-

Trade mark infringement especially among the corporate classes in India is rising on an alarming rate. Few of the notable cases have been described in brief.

1. Pantaloon dragged to court by Shoppers' Stop and Lifestyle; Westside also contemplates similar action, (July 14th, 2008).

Shoppers' Stop and Lifestyle have dragged their rival Pantaloon to court as they were miffed with an advertisement issued by the flagship company of Kishore Biyani owned Future Group that offered 10% extra discount to their loyal customers vide an advertisement issued in The Times of India, New Delhi, dated 28th June, 2008. The complainant retailers have accused Pantaloon of trademark violations and unfair business practices, says a Live Mint report. All the three parties operate department store format store chains in lifestyle segment. Even Westside has taken objection to the ad saying, "We have sent a notice to them to which they have not responded," said Smeeta Neogi, Head (Marketing) Westside.

Pantaloon's 'Central' mall at Gurgaon had offered 30% discounts to its customers over the weekend. Loyalty card holders of competing retailers like Shopper's Stop, Lifestyle and Westside, were lured by Pantaloon by offering an additional 10% discount on select brands of apparel. The advertisement asked such customers to: "Present your membership card to avail this offer."

Loyalty cardholders are mainstay of business for most retailers. Shoppers' Stop has a highly popular loyalty card programme branded "First Citizen." According to analysts, more than two-thirds of Shoppers' Stop's apparel business is accounted for by its loyal customers.

"They (Pantaloons) are luring my customers by using my name in an unfair manner," said Sandeep Mittal, the lawyer representing for both the petitioners.

The Honorable Delhi high court has issued an injunction restraining Pantaloons from using names of its rivals in the ads until the next hearing in the matter fixed for 31st July.

Taking potshots at these competitors is not new for Pantaloons. Last year, its Big Bazaar chain had put up hoardings, asking customers to "Keep West a Side," "Shoppers! Stop" and "Change Your Lifestyle. Make a Smart Choice."

2. Amul wins trademark case in Gujarat High Court, (Sep 24, 2007)

Amul has won the trademark case in the Gujarat High Court and no one else can use it.

The Kaira District Co-operative Milk Producers' Union Ltd. and GCMMF had filed trademark infringement cases, against two local shop owners. Amul Chasmaghar and its partners and Amul Cut Piece Stores in the District Court, Anand. The District Court, Anand passed an order dated 25 April 2007, ruling that it was a clear case of infringement and restrained the two from using the Amul trademark.

Amul Chasmaghar had challenged this interim injunction in the Gujarat High Court. The Gujarat High Court ruled the decision in favor of Amul, terming the order passed by the trial court as true, correct, legal, and in consonance with the facts of the case, as well as by the provisions of the Trade Marks Act 1999.

3. Trade Marks Disputes Involving the Pharmaceuticals Industry in India-

A. Beecham Group Plc. vs. S.R.K. Pharmaceuticals 2004 (28) PTC391 (IPAB)

The appellant has been using the mark 'AMOXIL' in India since 1990. This mark was registered in India in 1972 in Class 5 in respect of Pharmaceutical goods. The respondent started using the mark 'LYMOXYL' in India in 1985. The respondent applied for registration of the mark in 1987 in India in the same class concerning similar goods.

The appellant brought an action against the respondent stating that the mark is deceptively similar. The only difference between the two marks is in the prefix 'LY' and 'M'. The rival marks are phonetically and deceptively similar and the goods are pharmaceutical goods under Sec. 12(1) of the Act.

The Intellectual Property Appellate Board (IPAB) held that the respondent dishonestly adopted the mark by copying it from the appellant who had got the mark registered long ago. Hence the respondent cannot claim honest concurrent use, by virtue of earlier use. The Appellate Board delivered a judgment prohibiting registration of the Trade Mark 'LYMOXYL'.

B. Ranbaxy Laboratories Limited vs. Anand Prasad & 4 Others 2004 (28) PTC 438 (IPAB)

The appellant was the registered proprietor of the mark 'FORTWIN' and had been using the mark since 1975. The respondent applied for registration of the mark 'OSTWIN'. Both the marks related to pharmaceutical compositions in respect of treatment of bones.

The appellant brought an action against the respondent stating that the mark is deceptively similar. The IPAB held that the prefixes are 'FORT' and 'OST' while both the marks end with the suffix 'WIN'. It was further held that since the rival goods are also pharmaceutical goods it might lead to serious consequences due to deception or confusion in the minds of the public. Hence on the possibility of harm being caused to common person the appeal was allowed.

C. Wyeth Holdings Corp. & Anr. vs. Sun Pharmaceuticals Industries Ltd. 2004 (28) PTC 423 (Bom)

In this case the plaintiff whose former name was American Cynamid Company and who was the proprietor of the trademark 'PACITANE' registered the mark in Class 5 of Pharma goods. The respondent was using the mark 'PARKITANE' with respect to similar goods. The plaintiffs filed a suit for infringement and passing off and sought various reliefs including interim injunction against the defendant for using the mark 'PARKITANE'.

The Court held that in both the cases the goods are similar, being pharmaceutical preparations for treatment of Parkinson's disease, the customers buying these goods are the same and the trade channels are the same. Since the defendants did not show any search of the Register before adopting the impugned mark, prima facie adoption of the mark was not honest. Further, the Court held that despite protests, if the defendants have chosen to continue to sell the products, it cannot be said to be acquiescence by the plaintiff. Therefore the Court held that injunction is to be granted in favour of the plaintiff.

The Court further held that in case of pharmaceutical products, the test is of possibility of confusion and not probability of confusion. The plaintiffs have been in the field since 1950 and as such the balance of convenience is in their favour. The Court granted injunction in favour of the plaintiffs.

D. Hoechst Aktiengesellschaft vs. Artee Minerals & Anr. 2004 (28) PTC 470 (IPAB)

The appellant was the registered proprietor of trademark 'ARELON'. This mark was registered in class 5 with respect to pharmaceutical goods relating to preparation for killing weeds and destroying vermin. The respondent filed an application for registration of the mark 'ARTEELON' in the same class with respect to pharmaceutical goods.

The appellant opposed the application for registration of trade mark filed by the respondents on the ground that the registration of the impugned mark would be contrary to provisions of Sections 9, 11, 12(1) and 18 of the Trade and Merchandise Marks Act, 1958.

The IPAB held that the rival goods were same and the only difference was the letters 'TE'. The Appellate Board further held that the possibility of confusion and deception is not ruled out and hence affirmed the order rejecting the application for registration filed by the respondent. The IPAB further held that the benefit of use under Section 54 is given only in case of rectification proceedings when use of an associated trademark is deemed to be use of the registered trademark against which rectification proceedings are initiated for non-use of the mark.

Trade mark infringement / 'passing off' case in Malaysia

Background

A British manufacturer of biscuits has been selling cookies in Malaysia for more than 20 years, and has had a registered trade mark 'ChipsMore' for these goods during that time.

Two years ago a Malaysian company started manufacturing and selling cookies under the brand 'ChipsPlus.'

Advice

The British company was advised that they could sue the Malaysian company for trade mark infringement and also 'passing off', which can be used to enforce unregistered trade mark rights and exists in Malaysia as it is a Common Law country.

For trade mark infringement, the British company had to prove that the Malaysian company's brand so nearly resembled their own that it was likely to deceive or cause confusion in the course of trade in relation to their own products.

For 'passing off' the British company had to prove that the Malaysian company was misrepresenting their goods as being connected with the British company. They also had to prove that their own brand had acquired 'goodwill' and reputation in the marketplace, and that they would suffer damage as a result.

Outcome

The Malaysian court held that 'ChipsPlus' was an infringement of 'ChipsMore' as they were similar marks for identical goods and likely to deceive or cause confusion. In particular, the 'Chips' part was phonetically identical, the suffixes 'More' and 'Plus' have a similar meaning, and the formatting of the words was similar.

In addition, the claim for 'passing off' was successful. The British manufacturer had been selling cookies in Malaysia for over 20 years and therefore had no difficulty in demonstrating substantial goodwill and reputation in the brand. The appearance of the 'ChipsPlus' product was held to be strikingly similar to the 'ChipsMore' product, including similar colours, fonts and other aspects of the composition, which was indicative of misrepresentation. The court determined that the British manufacturer would therefore suffer damage (loss of business) if the Malaysian company was allowed to continue.

Lessons Learnt:

- Register your brands as trade marks in Southeast Asia
- A brand does not have to be identical to infringe a trade mark
- Some countries provide a Common Law right of 'passing off' (but the burden of proof is higher)